

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed January 30, 2009.

Claims 4-7 and 9-31 are pending in the present application and have been rejected. Claims 4-7 and 9-19 have been cancelled. Claims 4 and 29-31 have been amended. New claims 32-44 have been added. Support for all amended claims and new claims can be found in the specification, and no new matter has been added by these amendments. Consideration of the claims in view of the amendments and following remarks is respectfully requested.

I. 35 U.S.C. § 112 REJECTION OF CLAIMS 4-7 AND 9-19

Claims 4-7 and 9-19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action asserts that “the process of the invention appears to be defined through the use of structural components” and that “these structural components make it unclear which statutory class the Applicant intended.” Dependent claims 5, 6, 10-12, 14 and 16-19 are rejected for the same reason as claim 4.

Applicant has cancelled claims 4-7 and 9-19 without prejudice and, therefore, submits that the rejection under 35 U.S.C. § 112, second paragraph, of these claims is now moot. Further Applicant respectfully submits that new claims 32-43 recite subject matter that falls clearly within a respective class.

II. 35 U.S.C. § 102 REJECTION

Claims 4-7 and 9-31 are rejected under 35 U.S.C. § 102(b) as being based upon a public use or sale of the invention, ZeBU Corporation software (hereinafter “ZeBU”). In support of this rejection, the Examiner relies on a collection of references describing the ZeBU product (collectively referred to herein as the “ZeBU references”). Applicant respectfully traverses this rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As

discussed in the following paragraphs, the ZeBU product does not include every element as set forth in the pending claims.

A. Request for Information

On page 3 paragraph 8, the Office Action raises an issue of public use or on sale activity for the application. The Examiner requests additional information regarding public use or on sale activity of the ZeBU product, specifically, "How the ZeBU product, converted later to IIT, is different than the claimed." After a good faith attempt to obtain this information, Applicant respectfully submits that the information is unknown and not readily attainable. As best understood by Applicant, based on recollection and review of the cited references, any ZeBU product existing before the present invention did not include those features which are recited in the pending claims, but not taught or disclosed by the cited references. These features which distinguish the subject matter of Applicant's claims from any ZeBU product are discussed in more detail in the following paragraphs.

B. Claims 4-7 and 9-19

As noted above, Applicant has cancelled claims 4-7 and 9-19 without prejudice and, therefore, respectfully submits that the rejection of claims 4-7 and 9-19 under 35 U.S.C. § 102 is now moot.

C. Claims 20-31

As an preliminary matter, Applicant submits that the Office Action has yet to establish a *prima facie* case for an anticipation rejection of independent claim 20 under 35 U.S.C. §102. As noted above, to establish a *prima facie* case that a claim is anticipated under 35 U.S.C. §102, it must be established that each and every element of the claim is present in a single reference: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In the present rejection, the Office Action cites multiple documents which, as best understood by Applicant, describe at least two distinct pieces of software: (1) ZeBUNet (as described in ZeBulletin, April 2001) and (2) ZeBU AIMSuite (as described in ZeBU SEC Filing, ZeBU 08-2002, and other references). According to the Office Action on page 15, multiple documents are cited “to show that the structure not found within the primary art reference.” The Office Action on page 15 further explains that additional references “describe the structure the Applicant’s invention uses.”

Even assuming *arguendo* that the Office Action’s general rationale for combining multiple references is proper, “to anticipate a combination, the combination in its entirety must be old.” *Worthington v. Southern New Jersey Newspapers, Inc.*, 167 U.S.P.Q. 598, 610 (D. N.J. 1970) (citing *Bristol v. Otis Elevator Co.*, 10 U.S.P.Q. 212 (3d Cir. 1931)) (emphasis added). Accordingly, “all elements of the invention must be found in a single device in the prior art in order to negative novelty.” *Worthington*, 167 U.S.P.Q. at 610 (emphasis added).

In the present rejection, the Office Action at page 8 cites to ZeBulletin, April 2001, for “at least one client coupled to the at least one server, the at least one client adapted to allow access to the web-based system” and to the following documents for the remaining elements of claim 20: ZeBU SEC filing; ZeBU 08-2002; ZeBU Solutions—AIMSuite Overview; and Secure Internet Access to Application Status, Policy Data, Agent and Company Data. The portion of the ZeBulletin, April 2001 reference cited in the Office Action, an article entitled “ZeBU Introduces ZeBU Net” is directed to the ZeBU Net product. The remaining references are directed to the ZeBU AIMSuite which, as best understood by Applicant from the disclosure of the cited references, does not include the ZeBU Net product. The Office Action does not allege that either of the ZeBU AIMSuite or the ZeBU Net products individually anticipate Applicant’s claim 20, and, therefore, a *prima facie* case of anticipation has not been made with respect to either reference.

It is also further submitted that, as best understood from the above references, the ZeBU AIMSuite and ZeBU Net products do not anticipate Applicant’s claims. For example, claim 20 recites “a web-based system” that employs “a desktop visual metaphor.” The Examiner asserts that this limitation is disclosed by a reference entitled ZeBU Solutions—AIMSuite

Overview (hereinafter ZeBU Solutions) and by the components of the AIMSuite on pages 91-92¹ of Zebu's SEC filing (hereinafter "SEC filing"). Applicant respectfully disagrees. ZeBU Solutions, for example, provides a general description of the components of the AIMSuite family of products. For instance, ZeBU Solutions describes that "AIM GA gives the general agency the first fully integrated Agency Management system to automate all back office functions." Also, "AIM DMS sets the standard for initiating an insurance application at any point-of-sale location then distributes it through the application process." and "AIM ITS accommodates the gathering of essential application data directly from applicants using a reflexive telephone interviewing process, while printing out the completed application." The last component described in ZeBU Solutions is AIM Home Office, which "is instrumental in reducing the time and business costs associated with the underwriting/decision making process." ZeBU Solutions, however, is completely silent regarding "a desktop visual metaphor" as recited in claim 20.

Likewise, page 91 of the SEC filing does not disclose a "desktop visual metaphor" but lists features of the AIM WEB QUICKVIEW, AIM AGENCY QUICKVIEW, and AIM CARRIER QUICKVIEW products. Included in the SEC filing on pages 91 is a description that AIM QUICKVIEW "displays all pending case data for numerous carriers[...], tracks pending application cases[...], prints policies on-site[, and]...retains policy data onsite." Page 92 of the SEC filing describes that AIM GA is a "completely integrated and scalable agency management system, including plan administration and system administration integrated with a contact management system" and that AIM ITS is "insurance application tele-interview software with customizable interview template...integrated with AIM QuickView." The SEC Filing on pages 91-92 does not list or describe a "desktop visual metaphor" as one of the features of any component of the AIMSuite or any description of a desktop whatsoever. Therefore, it is respectfully submitted that the 35 U.S.C. § 102 rejection of claim 20 should be withdrawn at least for this additional reason.

¹ The SEC filing, as provided by the USPTO, is numbered differently in three places. From context, Applicant assumes that the numbering in the top-left corner of the pages was intended. Further, while the Office Action specifies page 90, because the Office Action specifies "components of the AIM Suite," which appear on pages 91-92, it is assumed that pages 91-92 were intended.

Claims 21-31 depend from claim 20 and, therefore, are allowable at least for depending on an allowable base claim. Further, Applicant respectfully submits that at least some of claims 21-31 are patentable for additional reasons. For example, claim 27 recites that “the workflow engine implements a plurality of workflows [of claim 23] comprising a plurality of tasks and subtasks executed in a predefined sequence” and claim 28 recites that “the plurality of workflows [of claim 23] comprises at least one public workflow and at least one private workflow.” The Office Action on page 10 asserts that these features are disclosed by the ZeBU HUB without any citation to any particular portion of the references. While several of the cited references (such as ZeBU Bulletin, April 2001, ZeBU Direct Marketing System (DMS), and the ZeBU SEC filing) mention the ZeBU HUB, a review of these references did not appear to disclose the above features of claims 27 and 28. For example, none of these references teach anything about public and private workflows comprising tasks and subtasks performed in a predefined sequence. For example, page 4 of the April 2001 ZeBU Bulletin describes that the ZeBU Hub “secures data that is being transferred, standardizes the data, and manages the flow of information among the various participants in the application and approval process.” Other than a general assertion that the ZeBU Hub “manages the flow of information” there is no mention of public or private workflows, or that workflows include tasks and subtasks. Therefore, it is respectfully submitted that claims 27 and 28 are allowable at least for this additional reason.

As another example, claim 29 recites “a view-state database” where “the view-state database [is] adapted to track, for said at least one user, a current state of a plurality of views of a plurality of said modules.” The Office Action asserts that a view-state database is disclosed by the AIM and WEB QuickView products. As with claims 21 and 31, the Office Action does not point to a specific reference for disclosure of this element and this element does not appear to be disclosed by applicable references. For example, the ZeBU SEC filing which describes the WEB QuickView product on page 91 does not appear to disclose a view-state database as recited in claim 29. On the contrary, the ZeBU SEC filing merely describes that the AIM Quickview product “automates and integrates the seamless movement of application, case and agent data throughout the insurance application process” and includes other features. None

of the features listed refer to view-states or a view-state database. Therefore, for at least this additional reason, it is respectfully submitted that claim 29 is allowable.

III. 35 U.S.C. § 103 REJECTION OF CLAIMS 29-31

Claims 29-31 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over ZeBU in view of Zundel et al (U.S. Patent No. 6,618,851) (hereinafter "Zundel"). The Office Action on page 12 asserts that "in the event that ZeBU does not explicitly teach the system further comprising a view-state database, the view-state database adapted to track a current state of the plurality of views[,] ZeBU further teaches the system further comprising a view-state database, the view-state database adapted to track a current state of the plurality of views (Abstract)." As the Office Action cites to an Abstract, which does not appear in any of the cited ZeBU references, it is assumed that the Office Action intends to cite to the Abstract of Zundel.

However, even assuming *arguendo* that the Abstract of Zundel teaches a "view-state database adapted to track a current state of the plurality of views," Applicant respectfully submits that claims 29-31 are not obvious under 35 U.S.C. § 103 in view of ZeBU over Zundel. For example, as noted above, claims 29-31 depend from claim 20, which is allowable at least because the ZeBU references do not teach "a web-based system" that employs "a desktop visual metaphor." Zundel does not appear to make up for this deficiency as the reference is directed to different subject matter, namely, providing "automatic support for state-reversion, undo, redo, and abort operations for application programs written with [a] programming environment." Therefore, for at least this reason, it is respectfully submitted that ZeBU and Zundel, either individually or in combination, do not teach all elements of claim 29.

Further, as amended claim 29 recites "a view-state database, the view-state database operable to track, for said plurality of users, a current state of a plurality of views of a plurality of said modules." Even assuming *arguendo* that Zundel teaches a view-state database (which it does not appear to do), Zundel still does not teach such a database that tracks a plurality of views of a plurality of modules for a plurality of users. On the contrary, it appears that Zundel

tracks the state of a single user using, for example, an application program such a CAD application program. See Zundel, column 3, lines 63-67. Accordingly, even if Zebu and Zundel were combined as indicated in the Office Action (even though there appears to be no motivation for the combination), the combination would not teach all elements of claim 29. Applicant thus submits that claim 29 is allowable under 35 U.S.C. § 103 over ZeBU in view of Zundel.

Claims 30 and 31 depend from claim 29 and, therefore, are allowable at least for the reasons that claim 29 is allowable.

IV. NEW CLAIMS 32-44

Applicant respectfully submits that new claims 32-44 are allowable at least for some of the reasons discussed above. In particular, Applicant respectfully submits that the ZeBU products and the Zundel reference do not anticipate claims 32-44 and do not render the claims obvious.

For example, claim 32 recites “providing a desktop visual metaphor to a plurality of users over a communications network.” As discussed above, the ZeBU references and the Zundel reference do not, either individually or in combination, teach or disclose this element. Therefore, it is respectfully submitted that claim 32 is allowable for at least this reason.

Further, claim 32 recites “providing access to a plurality of modules of an application through the desktop visual metaphor” and “facilitating, through the desktop visual metaphor, transfer of data among said users.” Because the ZeBU references and the Zundel reference do not, alone or in combination, teach the desktop visual metaphor, they also do not teach these elements reciting steps performed in connection with the desktop visual metaphor. Consequently, for this additional reason, Applicant respectfully submits that claim 32 is allowable.

Claims 33-37 depend from claim 32 and, therefore, are allowable at least for depending from an allowable claim. Further, at least some of claims 33-37 further recite patentable subject matter. For example, claim 36 recites “storing state information of the desktop visual metaphor for the plurality of users and wherein providing the desktop visual

metaphor includes presenting the desktop visual metaphor in accordance with the state information.” As discussed above, the ZeBU references and Zundel do not, either alone or in combination, teach this element and, therefore, is allowable under 35 U.S.C. §§ 102-103 over the ZeBU references and Zundel.

New independent claim 38 recites “a computer-readable storage medium including instructions for providing a desktop visual metaphor to a plurality of users over a communications network.” Claim 38 also recites “instructions for providing access to a plurality of modules of an application through the desktop visual metaphor” and “instructions for facilitating, through the desktop visual metaphor, transfer of data among said users.” As discussed above, the ZeBU references and Zundel do not, either alone or in combination, teach this element and, therefore, is allowable under 35 U.S.C. § 102-103 over the ZeBU references and Zundel.

Claims 39-44 depend from claim 38 and, therefore are allowable at least for depending from an allowable claim. Further, at least some of claims 39-44 further recite patentable subject matter. For example, claim 39 recites “instructions for storing state information for the plurality of users of the desktop visual metaphor and wherein said instructions for providing the desktop visual metaphor includes presenting the desktop visual metaphor in accordance with the state information.” As discussed above, the ZeBU references and Zundel do not, either alone or in combination, teach this element and, therefore, is allowable under 35 U.S.C. §§ 102-103 over the ZeBU references and Zundel.

V. AMENDMENTS TO THE CLAIMS

Unless otherwise specified, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the Specification as filed and do not add new matter.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

/Scott S. Adams/

Scott S. Adams
Reg. No. 63,302

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300

SSA:s5r

61808988 v1